

Notice of Allowability

Application No.

10/765,267

Applicant(s)

PAPPIN ET AL.

Examiner

Nyeemah Grazier

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 6/8/06.
2. ☒ The allowed claim(s) is/are 2-4, 9-16, 18-29, 31-42, 44-53, 71-74 (renumbered as 1-49).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 6/8/06, 7/3/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____.
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION
NOTICE OF ALLOWANCE

I. ACTION SUMMARY

The Amendments to the Claims and Remarks submitted to the Office on June 8, 2006 has been fully considered and will be the basis of the following Notice of Allowance.

Claims 2-4, 8-16, 18-29, 31-42, 44-53 and 71-74 are currently pending. Claims 72 was previously withdrawn and claims 73 and 74 are new claims.

II. INFORMATION DISCLOSURE STATEMENT

The supplemental information disclosure statements filed on June 8, 2006 and July 3, 2006 have been fully considered by the Examiner.

III. RESPONSE TO AMENDMENTS

A. Remarks on the Amendments to the Specification

Applicant's argument in the Remarks filed June 8, 2006 regarding the amendment to the Specification has been fully considered.

B. Remarks on the Amendments to the Claims

Applicant's arguments, see Remarks, filed June 8, 2006, with respect to the claim identifier filed in the Amendment to the Claims (Dec. 19, 2006) have been fully considered. The amendment to the claim identifier to correct the status of the claim is acknowledged.

Additionally, Applicant's arguments, with respect to the amendment of claims 20, 33 and 46 have been fully considered and are persuasive because the limitation "methoxy" has been deleted.

Next, Applicant's arguments, with respect to the amendment of claims 71 and its "salt" have been fully considered and are persuasive because claim 71 has been amended to include a salt.

Claims 3 and 4 and 8 were rejected because the claim was unclear. After consideration of the Amendments to the Claims, specifically claim 71, submitted on June 8, 2006, the rejection has been obviated.

C. Formal Matters _ Interview

Applicant states "Interview Summary prepared by Examiner Riley on May 25, 2006." Examiner believes this is in error. Please clarify.

D. Formal Matters-Status of the Claims

Applicant's arguments, see Remarks, filed June 8, 2006 with respect to claim 71 and Examiner's remarks on p. 2, paragraph I on the Action on March 20, 2006 has been considered. For clarity paragraph I states:

Additionally, Applicant request clarification as to the status of claims 28, 29, 31-32 and 34-40. As stated in the Action (March 20, 2006) and on the index of claims (PAIRS) said claims are in condition for allowance.

E. Obviousness-Type Double Patenting Rejection

Applicant's arguments, see Remarks, filed June 8, 2006, with respect to Obviousness-type Double Patenting Rejection have been fully considered. The applicant submitted a terminal disclaimer to the Office on September 11, 2006. Thus, the ODP has been obviated.

F. Claim Rejection under 35 USC 112, 2nd

Applicant's arguments, see Remarks Section 2b, pp. 20-21, filed June 8, 2006, with respect to the 112, 2nd rejection, have been fully considered and are persuasive in light of the Amendments to the claim. The rejection has been obviated.

G. Rejections under 35 USC 102

Applicant's arguments, see Remarks Section 3, pp. 21-22, filed June 8, 2006, with respect to the 102(b) rejection, have been fully considered and are persuasive. The rejection has been withdrawn because the prior art of record do not disclose isotopically enriched compounds.

H. Reconsideration of Method claims under In re Ochiai

Claims 2-4, 8-16, 18-29, 31-42, 44-53, 71, 73 and 74 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(B), claim 72, directed to the process of making a product using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, are hereby rejoined and fully examined for patentability under 37 CFR 1.104.

Because claim 72, previously withdrawn from consideration under 37 CFR 1.142 in the Action filed March 20, 2006, has been rejoined. In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claims including all the limitations of an allowable product claim or rejoined process claim are presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

IV. REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance: The instant invention is drawn to compounds pertaining to analyte determination. The instant invention appears to be free of the art of record. The closest prior art reference of record is JP 01125357 A2 (Sawayama et al.). Sawayama et al. discloses 1-[1-oxo-2-[4-(phenylmethyl)-1-piperazinyl]propoxy]-@-2,5-pyrrolidinedione. However, the disclosed compound is not isotopically enriched and is therefore not anticipated nor rendered obvious by the prior art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

V. CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:30 a.m. - 6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,



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